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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,898	11/17/2000	Boyce D. Burts JR.	23267/19C2	5603

7590 05/04/2004

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EXAMINER
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CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 05/04/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/715,898

Applicant(s)

BURTS, BOYCE D.

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 24-33 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-13 and 24-33 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

This Office Action is in response to Applicants' remarks filed December 10, 2003 and entered as Paper No. 11.

#### *Withdrawal of Rejections from Previous Office Action*

- All rejections from the previous Office Action have been withdrawn in view of the decisions of the BPAI (the Board), in related application 09/296,216, stating that there is no factual foundation to support the obviousness rejections. The Examiner believes that if the instant claims were appealed, the same decision, with regard to the obviousness rejections, would result. Thus, the Examiner is withdrawing the rejections under 35 USC 103 given in the previous Office Action.

#### *Claim Observations*

- Claim 13 recites "the additive" in the preamble. The claims should be amended to recite "The method" since the claim is dependent on claim 12, which is directed to a method.

#### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,716,798.

Although the conflicting claims are not identical, they are not patentably distinct from each other because, the instant claims recite a "tubing/casing annulus plug", whereas the claims of the '798 patent recite "conformance additive". However, the claims comprise the same components. Although the preamble is different, it is known that the recited components can be used in both tubing/casing plugs and as conformance additives.

3. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/296,217. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims recite a "tubing/casing annulus plug", whereas the claims of the '217 application recite "well lost circulation additive".

However, the claims comprise the same components. Although the preamble is different, it is known that the recited components can be used in both tubing/casing plugs and as well lost circulation additives.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending

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Application No. 09/307,544. Although the conflicting claims are not identical, they are not patentably distinct from each other because recite a "tubing/casing annulus plug", whereas the claims of the '544 application recite "well plug additive". However, the claims comprise the same components. Although the preamble is different, it is known that the recited components can be used in both tubing/casing plugs and as well plug additives.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 24-31 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,004,553 to House et al as taught by US Patent 4,722,397 to Sydansk.

House et al '553 teach a fluid additive for use in well working processes, where the additive forms a filter cake (plug) on the walls of the borehole. The fluid additive of House et al '553 comprise a combination of reinforcing materials such as oat hulls, corn cobs, cotton, citrus pulp, and cotton burrs. House et al '553 also disclose the conventional use of particulates of peanuts, almond, cocoa bean, cottonseed, rice, cotton linters, wool, paper, straw, wood fibers, etc. (col. 2, lines 7-27). House et al '553 disclose the use of the reinforcing particulate material in combination with a crosslinkable polymer (col. 5, lines 1-5). House et al '553 discloses suitable crosslinkable polymer as those described in U.S. Patent 4,722,397 to Sydansk (col. 20-

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38). The crosslinkable polymers of Sydansk '397 comprise a water-soluble carboxylate containing polymer and a cross linking agent such as chromic carboxylate complex, such as instantly claimed by Applicants. (See abstract of Sydansk '397.) The use of the cross-linkable polymer in combination with the reinforcing particulate materials forms a plugging agent for boreholes (col. 5, lines 1-9). With respect to the use of both hydrophilic and hydrophobic fibers, House et al teach hydrophobic treated cotton and hydrophilic cotton linters (col. 2, lines 7-26). House et al '553 further disclose the preparation of the fluids by adding the plugging additives to water based well working fluids (col. 5, lines 39-68 and col. 6, lines 1-25).

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,004,553 to House et al in view of U.S. Patent 3,208,524 to Horner et al.

The disclosure of House et al is described above. House et al differ from the invention recited in claims 32 and 33 in that cellophane is not disclosed as being a part of the fluid additives.

Horner et al '524 teach loss circulation fluids similar to those disclosed by House et al '553 in that they comprise crosslinkable polymers. Horner et al '524 teach the employment of bulking agents into the polymer gels to reduce the amount of gel required and to permit the plugging of large fissures which might otherwise be difficult to plug (col. 5, lines 42-48). As bulking agents, Horner et al '524 discloses cellophane and a variety of other fibrous, flaky or granular materials.

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Thus, in view of the teaching of the use of cellophane in combination with other fibrous, flaky or granular materials in loss circulation additives for well working fluids, it would have been obvious to one of ordinary skill in the art to employ cellophane as an additional component of the loss circulation additive of House et al '553. One of ordinary skill in the art would expect that the addition of cellophane to the fluids of House et al '553 would result in a plugging additive having enhanced plugging ability capable of plugging difficult holes.

### *Response to Arguments*

9. Applicant's arguments filed October 10, 2003 have been fully considered but they are not persuasive. Applicants argue that the Board decided that there was no factual foundation for the obviousness rejections in related application 09/296,217. Applicants should note that the Board decision was made with respect to the dry mixture of cross-linkable polymer, cross-linking agent and reinforcing material. Claims 24-33, rejected above, do not require a dry mixture of cross-linkable polymer, cross-linking agent and reinforcing material.

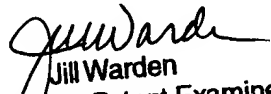
Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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